Appl. No. 09/533,152
Response to Office Action Mailed April 5, 2006
Response Filed October 5, 2006

Express Mailing Label No.
EV 873497322 US

REMARKS

A.   Generally

Applicant wishes to thank the examiner for providing Applicant the opportunity to discuss the reference and the claims. Applicant has provided an interview summary contemporaneous with the filing of this Amendment.

Claims 29-56 remain in this application. Claims 1-28 have been canceled.

Applicant has filed a request for continued examination contemporaneous with this Amendment.

B.   Claim Rejections -- 35 USC §103

Claims and 16-28, have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Ginter, et al., Pat. Pub. No. US 200510246541.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (MPEP §2143.03; 8th Ed, Rev. 2; citations omitted.) The Federal Circuit has repeatedly warned against using an applicant's disclosure as a blueprint to reconstructed the claimed invention out of isolated teachings of the prior art. *See, Grain Processing Corp. V. American Maize Products,* 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988). This principle is also embodied in prohibition against the application of hindsight:

> A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then accepted wisdom in the field. ...Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." (*In re Kotzab,* 217 F.3d 1365, 1359, 55 USPQ2d 1313, 1316 (citations omitted) (Fed. Cir. 2000).)

Applicant submits that the inferences and conclusions drawn from Ginter amounts to reconstruction of the elements of claim 1 (as examined) from isolated teachings of that reference using hindsight. The office action concluded that one skilled in the art would read Ginter and determine from its teachings a method for conducting a transaction using an electronic container as claimed in claim 1 (as examined). Applicant submits that one skilled in the art would not

Appl. No. 09/533,152
Response to Office Action Mailed April 5, 2006
Response Filed October 5, 2006

Express Mailing Label No.
EV 873497322 US

have drawn the conclusions about the Ginter reference without reference to the present

application. Thus, the blueprint for articulating a method for conducting a transaction using an

electronic container is not Ginter but the present application.

Based on the foregoing, Applicant submits that a *prima facie* case of obviousness has not

been made and that the claims of the present application are allowable over the cited prior art.

Even assuming that Ginter may be applied to the claims of the present application,

Applicant further submits that Ginter does not disclose the subject matter ascribed to it by the

office action.

Claim 1 (as examined) recites the following limitations:

> A method for conducting a transaction using an electronic container comprising:
>
>> acquiring a data file, wherein the data file comprises content useful in conducting the transaction;
>>
>> creating information about the data file;
>>
>> associating the information about the data file with the data file;
>>
>> assigning a unique transaction identifier to the transaction;
>>
>> associating the data file and the information about the data file with the transaction identifier;
>>
>> forming an electronic container by storing the data file and the information about the data file with other data files and information about the other data files having the same transaction identifier; and
>>
>> providing the electronic container to a participant of the transaction, wherein the participant may access the data file and other data files in accordance with access rules established in the information about the data file and the information about the other data files.

In rejecting claim 1 (and independent claims 7 and 13), the office action cited the

following text from Ginter:

> [0273] Also as shown in FIGS. 88 and 89, appliance 600A in this example has a secure processing unit (SPU) 500 (see FIG. 6). SPU 500 provides a tamper-resistant protected processing environment ("PPE") in which processes and transactions can take place securely and in a trusted fashion.
>
> [0274] FIG. 91A shows example steps for sending an item such as item 4054. To send item 4054 to recipient 4056, sender 4052 may first press buttons 4106 and read display 4104 to select between different delivery options (see FIG. 91A, step

Appl. No. 09/533,152
Response to Office Action Mailed April 5, 2006
Response Filed October 5, 2006

Express Mailing Label No.
EV 873497322 US

4090A). FIG. 90A shows some example service options, and FIG. 90B shows some more detailed delivery options. For example, sender 405' might press a button corresponding to "delivery options," which might cause appliance 600A to display the FIG. 90A menu screen of various delivery options. These delivery options could include, for example:

[0275] receipt options (what kind of receipt, if any, sender 4052' wishes to receive documenting delivery of item 4054 to intended recipient 4056);

[0276] integrity guarantee options (providing high levels of assurance that item 4054 was delivered in its entirety without any errors, and without any accidental or intentional modifications);

[0277] privacy options (for example, whether recipient 4056 is to know who sender 4052 is or where she has sent the document from); and

[0278] more options.

[0279] Electronic appliance 600A may also ask the user to identify intended recipient 4056 (FIG. 91A, step 4090B). Sender 4052 may select different ways to identify recipient 4056 based on the confidentiality of the document and the level of security the sender is willing to pay for. In one example, sender 4052 might require the recipient's appliance 600B to require recipient 4056 to prove that he is who he says he is. This secure "authentication" function might be met by, for example, requiring recipient 4056 to input a password, present digital proof of identity using, for example:

[0280] a digital document or "certificate" issued by a trusted third party, and/or

[0281] have appliance 600 measure a biometric characteristic of the recipient such as, for example, taking the recipient's photograph (and possibly automatically compare it with a known photograph of the recipient supplied by sender 4052 or system 4050) or using any other biometric sensing technique.

And:

[0290] After appliance 600 has scanned or otherwise received the entirety of document 4054 or other item, appliance 600 may calculate and display a total price on computer screen 4104 and ask sender 4052 to pay for the service (FIG. 91A, block 4090D). The calculated price may, for example, depend in part on the size and/or number of items to be securely delivered. The appliance may then ask sender 4052 to confirm she wishes to send the document to the recipient 4056 (FIG. 91A, block 4090E). Upon receiving that confirmation (FIG. 91A, "y" exit to decision block 4090E), appliance 600 may request sender 4052 to pay, for example, by inserting her credit card into card reader 4108 as a form of payment,

Appl. No. 09/533,152
Response to Office Action Mailed April 5, 2006
Response Filed October 5, 2006

Express Mailing Label No.
EV 873497322 US

or it might use other payment arrangements (FIG. 9aA, block 4090F). Appliance 600 may then package the digital form of document into secure electronic container 302 and send it over electronic network 4058 for secure delivery to recipient 4056 (FIG. 91A, block 4090F). Because system 4050 uses the secure "virtual distribution environment" 100, sender 4052 can have a high degree of confidence and trust that item 4054 will be usable only by intended recipient(s) 4056 and to no one else.

[0291] FIG. 91B shows example steps for receiving an item. Intended recipient 4056 may receive delivery of the document by walking up to the same or different electronic appliance intelligent kiosk 600B and operate controls 4106 instructing the appliance to deliver the document to him (FIG. 91B, block 4092A). Depending upon the delivery options sender 4052 selected, appliance 600 may require recipient 4056 to prove he is who he says he is (FIG. 91B, block 4092B). For example, appliance 600B may require recipient 4056 to provide a secret password and/or it may require the recipient to insert a special card into card reader 108. This special card may certify the identity of recipient 4056. Appliance 600B might also take the recipient's picture using camera 4124, and automatically compare the picture with a known photographic image of the recipient to see if they match. Once appliance 600 is satisfied regarding the identity of recipient 4056, it may require the recipient to pay (FIG. 91B, block 4092C)-- such as for example in a "collect on delivery" model. The appliance 600 may then open the secure electronic container ("attach case") 302 and deliver the item it contains to recipient 4056 (FIG. 91B, block 4092D). For example, if the container 302 contains item 4054, prints the copy of the document, and provides the printed copy through document slot 4102. It could also give recipient 4056 a digital copy of the item 4054 (such as a document) via media drive 4132 and/or port 4130. Appliance 600B may deliver the digital copy of item 4054 within a container 302 and/or may protect the item with seals, electronic fingerprints, watermarks and/or other visible and/or hidden markings to provide a "virtual container" or some of the security or other characteristics of a container (for example, the ability to associate electronic controls with the item).

The office action found that the limitation "creating information about the data file" was taught or reasonably described by the disclosure of Ginter [0274] that a user of the Ginter system could select different delivery options. According to Ginter [0275]-[0278], delivery options include receipt options, integrity guarantee options, and privacy options. Nothing in these excerpts requires knowledge of the content of the file. Applicant respectfully submits that a "delivery option" may be selected without knowledge of the content of a file and that even under the broad reading of "information about the data file" as applied by the office action the cited language does not teach or reasonably suggest the limitation.

Appl. No. 09/533,152
Response to Office Action Mailed April 5, 2006
Response Filed October 5, 2006

Express Mailing Label No.
EV 873497322 US

The office action determined that the limitation, "associating the information about the data file with the data file," was met by the disclosure by Ginter in ¶ [0279] that electronic appliance 600A may also ask the user to identify intended recipient 4056 based on the confidentiality of the document and the level of security the sender is willing to pay for. The office action inferred that the act of identifying the intended recipient required that information about the file be associated with data file itself. However, Ginter suggested otherwise. In one example cited in Ginter, sender 4052 requires the recipient's appliance 600B to require recipient 4056 to prove that he is who he says he is. The examples provided by Ginter (using digital certificates or biometric characteristics) can be accomplished without any information about the file and without associating an information about a file with a file.

The office action determined that the limitation, "assigning a unique transaction identifier to the transaction," was met by the disclosure by Ginter in ¶[0282] that sender 4052 may also specify the electronic address of recipient 4056, or it might let system 4050 automatically, securely and confidentially locate the recipient using a secure directory service. Applicant submits that a transaction may require that any number of containers be sent to the same "address." Thus, addressing an electronic container does not uniquely identify the transaction and cannot be reasonably equated to the "unique identifier" recited in claim 1.

The office action acknowledges that Ginter does not explicitly disclose, "forming an electronic container by storing the data file and the information about the data file with other data files and information about the other data files having the same transaction identifier." The office action determined that this limitation was obvious in light of the disclosure in Ginter that the file that could be sent could be one of a number of different file types. However, nothing in the cited Ginter excerpts suggests combining different files associated with the same unique transaction identifier and further associated with information about the files. Applicant respectfully submits that this conclusion ignores the plain meaning of the Ginter excerpts and represents an overly broad reading of the reference in light of the structure of claim 1.

The foregoing arguments apply to the other independent and dependent claims.

Applicant respectfully submits that claims 1-7, 9-14, and 16- 28 as examined are allowable over the cited reference.

Appl. No. 09/533,152
Response to Office Action Mailed April 5, 2006
Response Filed October 5, 2006

Express Mailing Label No.
EV 873497322 US

C.   Amended Claims

Applicant has canceled the examined claims without prejudice. New claims 29-56 recite limitations directed to using a template to select files for inclusion in a container. These limitations are supported by the Specification of the present application. For example, the Specification provides:

> Documents may be grouped and organized in a fashion that best suits the needs of the sender or recipient. Therefore, rather than, for example, having a list of 100 TIFF images displayed for which the recipient must determine the significance, the document delivery system of the present invention will allow the identification of the documents as a note, deed of trust, insurance claim or legal case file by sorting information that is represented in a barcode symbol that can be read in a machine readable fashion. This eliminates the user from having to deal with information that is not relevant, such as a TIFF image, freeing the user to deal with issues that are important, such as the terms of a note, claim or case. Further through the use of templates, documents may be organized where regardless of the point in time the object is added to the package, that the object will be presented in a consistent fashion. (Specification, at pp. 14-15.)
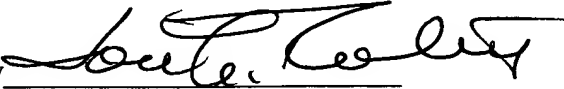
The above excerpt is but one of numerous references to "template" in the Specification of the present application. Other disclosures regarding templates may be found at page 20, lines 9-23, page 21, lines 1-7, and page 26, lines 1-15.

D.   Conclusion

In view of the above information and remarks, Applicant respectfully requests reconsideration of the current rejections. Applicant further requests that a timely Notice of

Appl. No. 09/533,152
Response to Office Action Mailed April 5, 2006
Response Filed October 5, 2006

Express Mailing Label No.
EV 873497322 US

Allowance be issued in this case. Should any further questions arise concerning this application or in the event the above amendments do not place the application in condition for allowance, Applicant respectfully requests a telephone interview. Attorney for the Applicant may be reached at the number listed below.

Respectfully Submitted,

By

Jon L. Roberts, Ph.D., J.D.
Registration No. 31,293
Elliott D. Light, Esq.
Registration No. 51,948
ROBERTS MARDULA & WERTHEIM, LLC
11800 Sunrise Valley Drive, Suite 1000
Reston, VA 20191
703-391-2900